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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,729	07/12/2006	Tadashi Maeda	043890-0927	7206
20277 7590 10/14/2010 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER SAAD, ERIN BARRY				
ART UNIT		PAPER NUMBER		
1735				
MAIL DATE		DELIVERY MODE		
10/14/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,729

Applicant(s)

MAEDA ET AL.

Examiner

ERIN B. SAAD

Art Unit

1735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/12/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
_____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is indefinite because it is unclear what is meant by "letting molten solder come in contact with the second electrode by melting the solder portion under heat and wetting and spreading the molten solder along surfaces of the metal powder included in the soldering paste with guiding the molten solder". For the purpose of Examination, the limitation will read "letting molten solder come in contact with the second electrode by melting the solder portion under heat and wetting and spreading the molten solder along surfaces of the metal powder included in the soldering paste by guiding the molten solder".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (US 6,189,771) in view of Mei (US 6,680,128), and further in view of the collective teachings of Kodas (US 6,951,666) and Kang et al (US 5,837,119).

In regards to claim 4, Maeda discloses a method for soldering a first electrode 18 with a solder portion 19 to a second electrode 12 by melting under heat the solder portion of the first electrode (column 4 lines 38-51), as observed in the sequences depicted in figures 4A-4B, where electrode 18 (shown but not labeled in figure 4; shown and labeled in figure 3 which is an embodiment of figure 4) and electrode 12 are the first and second electrode, respectively.

Maeda discloses (a) coating a metal (solder) paste 5 on at least one of the solder portion 19 of the first electrode, the soldering paste comprising liquid basis formed of resin (flux) component, an activator for removing oxide film produced on the surfaces of the solder portion (column 4 lines 1-8). Maeda discloses that the solder portion is

melted and the solder portion wets the metal paste (column 4 lines 22-36). It is the Examiner's position that this would indicate the solder portion easily wets and spreads along the surface of the solder paste when the solder portion is fluidized.

Maeda discloses (b) positioning the first electrode directly above the second electrode so the metal paste 5 placed between the solder portion (on the solder ball 19) of the first electrode and the second electrode (metal paste 5, figures 4A-4B).

Maeda discloses (c) letting solder come in contact with the second electrode by melting the solder under heat and wetting and spreading the molten solder along the surface of the metal powder included in the solder paste by guiding/directing the molten solder (column 3 lines 22-35 and column 5, lines 13-65).

Maeda discloses (d) solidifying the molten solder after letting molten solder come in contact with the first electrode and the second electrode, thereby forming a soldered portion which connects the first and second electrode (column 4 lines 21-36).

Maeda teaches that the metal paste is made by mixing a metal and flux (column 4, lines 1-4). However, Maeda fails to teach that the paste includes a liquid basis formed of resin component, an activator removing oxide film produced on surfaces of the solder portion, a metal powder having a core metal and a surface metal to cover surfaces of the core metal.

However, Mei teaches solder pastes where a particular solder composition is most preferably a metal alloy of tin and zinc (core metal) coated with a material preferably selected from copper, silver, palladium, tin, or gold (Column 2, lines 19-24). Mei also teaches that the coated solder composition used in the solder paste is also

suitable for being combined with a flux containing a rosin, derivatives of a rosin such as a dimerized resin, an activator, and a solvent (Column 4, lines 40-49), thus the paste would have a sense of liquidity (liquid basis).

In view of Mei's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine, with Maeda's soldering method that solders together two electrodes by a soldering bump through the use of a soldering paste, a particular soldering paste that contains a core and surface metal, since using a paste that contains a core and surface metal would allow for lower melting points, longer shelf life, and better effective wettability properties (Mei, Column 3, lines 5-10).

Since Maeda teaches a similar soldering method as the current invention (as stated above) and the solder paste of Maeda as modified by Mei is not structurally indistinguishable from the solder paste of the current invention, it would necessarily flow that the surface of the core metal is exposed at a portion of the metal powder which is not in contact with the molten solder while the surface metal is taken into the core metal by dissolution. Even though a portion of the surface metal powder may not be in contact with the molten solder, the surface metal powder would still be heated and melted when the components are placed in the reflow furnace.

Maeda does not specifically disclose the shape of the metal powder. Mei discloses that the solder powder may be spherical or amorphous (column 3 lines 55-63). This would indicate that Mei is open to the powder being different shapes, including flake-like. While Mei does not *specifically* disclose using a metal powder with a flake-like shape, Kodas teaches the use of metal powders that have a flaky form with

very large aspect ratios (column 4, lines 60-66) to form conductive features (column 35, lines 1-18). Where according to Kang et al, soldering or electrically conductive pastes (column 2, lines 20-25) with metal powders in the flaky form because of their higher aspect ratios are more desirable than metal powder in the regular spherical form because flaky powders provide for better electrical conduction because of their larger aspect ratios, i.e. length of the flake is larger than the width of the flake (Kang, column 5, lines 35-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Maeda in view of Mei to use flake-like metal powders since their higher aspect ratios allow for better electrical conduction, as taught by the collective teachings of Kodas and Kang.

Maeda does not specifically disclose the amount of metal powder in the solder paste. Mei discloses that the soldering paste is *typically* will be formed by combining the flux to form a paste comprising *about* 50 vol% solder to 50 vol% flux. This is not within the range of 1-20 vol% as disclosed by the claim; however, Mei discloses that this is *typically* the amount used to form the paste which indicates that other amounts are also possible. Mei also states that the concentration of coated metal powder in the solder paste can affect various properties of solder paste such as, for example, viscosity, ease of deposition, slumping, tack retention and shelf life and also that the concentration of solder powder in the paste also affects the thickness of the solder remaining after the paste is re-flowed (column 4 lines 56-66). This would indicate that it would have been obvious to one of ordinary skill in the art at the time of the invention to determine a suitable amount of powder to flux within the solder paste to create a solder

paste with properties desired for the bonding process since it has been held that discovering an optimum value or a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In regards to claim 5, Mei teaches that the solder composition (core metal) can be either tin or zinc, while the coating material (surface metal) can be copper, silver, palladium, tin, or gold (Column 2, lines 19-24).

In regards to claim 6: Mei teaches that the core metal includes tin or tin-based alloy, and the surface metal includes silver (column 2, lines 19-24).

Response to Arguments

6. Applicant's arguments filed 8/12/2010 have been fully considered but they are not persuasive.

7. The Applicant argues that none of the references disclose "the solder portion easily wets and spreads along the surface metal when the solder portion is fluidized" because Mei does not intend to wet and spread the molten solder along surfaces of the metal powder because Mei describes that surface metals include copper or tin which are not expected to have an effect on wetting and spreading the molten solder along the surfaces of the metal powder guiding the molten solder.

The Examiner disagrees. Maeda discloses that the solder portion is melted and the solder portion wets the metal paste (column 4 lines 22-36). It is the Examiner's position that this would indicate the solder portion easily wets and spreads along the surface metal when the solder portion is fluidized.

Mei discloses that the surface metal may be silver or gold (as well as tin, copper or polymers). Silver and gold are similar materials to the present invention. Since Mei discloses that the surface metal may be similar materials to the present invention, it is the Examiner's position that surface metal of Mei would have the same wetting and spreading properties as the current invention.

8. The Applicant argues that none of the cited references disclose or even suggest and "an amount of the flake-like metal powder in the soldering paste is 1-20vol%.

The Examiner disagrees. As stated in the rejection above, Maeda does not specifically disclose the amount of metal powder in the solder paste. Mei discloses that the soldering paste is *typically* will be formed by combining the flux to form a paste comprising *about* 50 vol% solder to 50 vol% flux. This is not within the range of 1-20 vol% as disclosed by the claim; however, Mei discloses that this is *typically* the amount used to form the paste which indicates that other amounts are also possible. Mei also states that the concentration of coated metal powder in the solder paste can affect various properties of solder paste such as, for example, viscosity, ease of deposition, slumping, tack retention and shelf life and also that the concentration of solder powder in the paste also affects the thickness of the solder remaining after the paste is re-flowed (column 4 lines 56-66). This would indicate that it would have been obvious to one of ordinary skill in the art at the time of the invention to determine a suitable amount of powder to flux within the solder paste to create a solder paste with properties desired for the bonding process since it has been held that discovering an optimum value or a

result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIN B. SAAD whose telephone number is (571)270-3634. The examiner can normally be reached on Monday through Thursday from 8am-5pm Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on (571) 272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. B. S./
Examiner, Art Unit 1735
10/7/2010

/Jessica L. Ward/
Supervisory Patent Examiner, Art Unit 1735